

REMARKS

Claims 1-6 are presently pending in the application.

Applicants have amended claims 1-5 to correct grammatical errors, particularly to correct antecedent basis for singular and plural verbs and nouns. Additionally, claim 1 has been amended to recite the feature of the retaining plate consisting essentially of two plates having an undulate cross section and hollow sections which are separated from one another. This feature was recited in original claim 2, except that the transitional phrase “composed of” was replaced with the phrase “consist essentially of”. Thus, support for this amendment to claim 1 can be found, for example, in original claim 2. New claim 6 is allowable claim 3 rewritten in independent form. No new matter has been added by these claim amendments, and entry of the amendments is respectfully requested.

In Paper No. 7, the Examiner has required restriction between the claims of Group I (claims 1-4), which are asserted to be drawn to a polymer electrolyte fuel cell comprising specific retaining plates, and Group II (claim 5), which is asserted to be drawn to a method of using a polymer electrolyte fuel cell. The Examiner has withdrawn claim 5 from consideration and takes the position that the inventions listed as Groups I and II do not relate to a single general inventive concept under P.C.T. Rule 13.1 because, under P.C.T. Rule 13.2, they lack the same or corresponding special technical features. The Examiner argues that the special technical feature, *i.e.*, the retaining plate forming a gap between unit cells to remove them, is known in the art and thus does not provide a contribution over the prior art as evidenced by U.S. Patent No. 6,190,793 B1 of Barton et al. (“Barton”).

Applicants affirm the provisional election of Group I (claims 1-4), with traverse, made by William Schwarze on May 19, 2003. Applicants argue, most strenuously, that the Examiner’s

restriction requirement is inappropriate considering that there was no requirement of non-unity of the invention in the PCT process. In the telephone conversation with the Examiner, the Examiner noted that the first reference (JP 63-16576) cited in the International Search Report was cited as category X with respect to claim 1, but only Category A with respect to claim 5, and therefore, there is no special technical feature of novelty in claim 1, but there is in claim 5, so that a lack of unity objection is proper. However, this holding of lack of unity is no longer applicable, since claim 1 has been amended to incorporate the structural feature of claim 2 which was found to be allowable. Moreover, the Examiner ultimately found JP 63-16576 not to be fully relevant (see paragraph 18 at page 10 of the Office Action). Accordingly, withdrawal of the restriction requirement and examination of all of the pending claims (claims 1-5) are respectfully requested.

At paragraph 7 of Paper No. 7, the Examiner objects to the formal drawings of Figures 1-2 arguing that Figures 1-2 should be designated by a legend such as "--PRIOR ART- -" since only that which is old is illustrated. In response, Applicants have elected to replace the formal drawings of Figures 1-2 with new formal drawing sheets of Figures 1-2 that include a legend "- - PRIOR ART--". See Exhibit A attached hereto. Approval of the new formal drawing sheets of Figures 1-2 is respectfully requested as are reconsideration and withdrawal of the Examiner's objection to Figure 1 and Figure 2.

The Examiner has also objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(5) since the specification does not identify reference signs 51-59. Applicants have amended the specification to include identification of reference signs 51-59. Therefore, reconsideration and withdrawal of the Examiner's objections to the drawings under 37 C.F.R. 1.84(p)(5) are respectfully requested.

The Examiner objects to the Abstract of the application at paragraph 9 of Paper No. 7. Applicants have deleted the Abstract and replaced it with a new Abstract to clarify a narrative description of the present invention. Accordingly, reconsideration and withdrawal to the objection to the Abstract are respectfully requested.

No new matter has been added by the above-mentioned amendments to the Specification. Accordingly, entry of the amendments is respectfully requested.

Allowable Subject Matter

On page 10, paragraph 17 of Paper No. 7, the Examiner has stated that claims 2-3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. At paragraph 15, the Examiner provides a statement of reasons for the allowable subject matter stating that “a reasonable search for the prior art failed to reveal or fairly suggest what is instantly claimed, particularly: a) the retaining plate composed of two plates having the specific structural configurations as recited in claim 2; and b) the separator plate and the retaining plate satisfying the specific structural arrangement as recited in claim 3. For example, the prior art of record i.e., Barton, et al. ‘793 and Sawyer ‘597 does not disclose these features.” However, at paragraph 16, the Examiner notes that, with respect to claim 2, the transitional phrase “composed of” has been interpreted in the same manner as “consisting essentially of” based on the disclosed specification. As such, the Examiner explains, that the transitional phrase “composed of” limits the scope of a claim to the specific materials (features) and those that do not materially affect the basic and novel characteristics of the claimed invention.

Applicants thank the Examiner for this statement of allowable subject matter.

Accordingly, claim 3 has been rewritten in independent form as new claim 6 and the structural feature of claim 2 which the Examiner referred to has been incorporated in claim 1. The function of the hollow sections, namely flowing cooling water therethrough has been left in claim 2, as this did not appear to be the basis for the Examiner's indication of allowability.

The Examiner has rejected original claim 1 under 35 U.S.C. §102(e) as being anticipated by Barton, arguing that Barton discloses an electrochemical fuel cell stack essentially as claimed in the present invention. Also, the Examiner has rejected original claim 4 under 35 U.S.C. §103(a) as being unpatentable (obvious) over Barton as applied to claim 1, and further in view of U.S. Patent No. 4,198,597 of Sawyer. The Examiner acknowledges that Barton does not disclose a voltage measurement jig and a voltage display device, but argues that it would have been obvious to one skilled in the art at the time the invention was made to incorporate the voltage measurement jig and the voltage display device of Sawyer into the fuel cell system of Barton, as Sawyer discloses that such devices for detecting and displaying voltage are used for sensing defective cells among a plurality of voltage producing cells which together form a source of electrical power, such as the fuel cell.

While not necessarily agreeing with the Examiner's rejections, and the arguments in support thereof, Applicants have elected to amend claim 1 as described above. Applicants argue, most strenuously, that the prior art of record does not teach or suggest all of the features of the polymer electrolyte fuel cell as presently recited in amended claim 1. In particular, neither Barton nor Sawyer teaches or suggests the polymer electrolyte fuel cell as claimed having a retaining plate consisting essentially of two plates having an undulate cross section and hollow sections which are separated from one another (see amended claim 1). Moreover, it is not

obvious to provide a polymer electrolyte fuel cell having a retaining plate consisting essentially of two plates having an undulate cross section and hollow sections which are separated from one another (see, e.g., page 8, lines 6-16 of the specification). As such, claim 1 should now be found to be allowable. Since claims 2-4 depend directly from claim 1, claims 2-4 should also be found to be allowable.

In view of the foregoing Amendment and Remarks, Applicants submit that claims 1-6 are patentably distinct from the prior art of record. Accordingly, reconsideration and withdrawal of the Examiner's restriction requirement and rejections, and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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